1. Applicant's election without traverse of Group I, claims 1, 2, and 15-26 in the reply filed on 08/13/09 is acknowledged.

2. Claims 27 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/13/09.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. Claim 18 is objected to because of the following informality: the language "each variable gene insert**s** is from". Correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are confusing because it cannot be determined what is encompassed by a "target molecule" in claims 23 and 24. Clarification is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 15, 16, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Neri et al. (US 2004/0014090).

These claims are drawn to a method comprising: selecting inserts from a gene library according to a desired characteristic; conducting amplification on said inserts to produce a mixed PCR product; ligating the components of the mixed PCR product to produce a concatamer; and sequencing or determining the occurrence of the inserts in the concatamer.

Neri et al. disclose such a method; see Fig. 7 and paragraphs 0015, 0021-0024, 0032, 0070-0071, 0076, 0083-0084, and 0105.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17, 18, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neri et al.

These claims are drawn to the method as described and rejected above, wherein the concatenated sequence is of a certain size (claim 17), the length of the insert is of a certain size (claim 18), or a target molecule is characterized or quantitated (claims 23 and 24), specifically using FRET (claims 25 and 26).

One of ordinary skill in the art would have been motivated to routinely optimize the size of the concatenated sequence and insert in the method of Neri et al., as well as to use conventional characterization and quantitation means, such as fluorescence resonance energy transfer. Routine optimization of reaction parameters cannot serve as the basis for unobviousness (see M.P.E.P. 2144.05). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to carry out the claimed methods.

8. No claims are free of the prior art.

9. The following are made of record as references of interest: Pruitt et al. (US 7,323,313), Maekawa et al. (US 7,189,810), Kinzler et al. (US 5,695,937), Goldsmith et al. (US 2004/0110174), and Sorensen et al. (US 2005/0164162).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Horlick whose telephone number is 571-272-0784. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

10/22/09